

REMARKS / ARGUMENTS

A. Status of Claims

Claims 1, 3-15, 20 and 21 are pending in the application. Claims 1, 3-15, 20 and 21 stand rejected. By this amendment, Claims 1 and 5 were amended, leaving Claims 1, 3-15, 20 and 21 for consideration upon entry of the present Amendment.

Applicant respectfully submits that the rejections under 35 U.S.C. §103(a) have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

B. Nonstatutory Obvious-type Double Patenting

Claims 1, 3-15, and 20-21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of Burnell (U.S. Patent 7,308,299) in view of Daum (U.S. Patent 6,704,600) in further view of Richey (U.S. Patent 4,547,892). Applicant has submitted herewith a terminal disclaimer to obviate the foregoing rejection. Reconsideration and withdrawal of this rejection is respectfully requested.

C. Rejections Under 35 U.S.C. §103(a)

Claims 1 and 3-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Daum (U.S. Patent No. 6,704,600, hereinafter Daum).

Applicant respectfully submits that the obviousness rejection based on the References is improper as the References fail to teach or suggest each and every element of the instant invention in such a manner as to perform as the claimed invention performs. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598

(Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are taught or suggested in the prior art. MPEP §2143.03. It is the Applicants burden to establish that a step practiced in the prior art is excluded from the claim by “consisting essentially of” language. *Ex parte Hoffman*, 12 U.S.P.Q.2d 1061, 1063, 1064 (B.P.A.I. 1989).

Regarding Claims 1 and 3-9, Applicant respectfully submits that Claims 1 and 3-9 are not obvious in light in of Daum. In the office action the Examiner states that the fact Richey discards images outside of thresholds has no bearing on whether the claim limitations are met when the Applicant chooses to use comprising language in the claims. [paper 20080317, page 2].

In an effort to expedite allowance and issuance of Claims 1 and 3-9, Applicant has amended Claim 1 and therefore Claims 3-9 which depend directly or indirectly from Claim 1. This amendment changes the comprising language to be “consisting essentially of.” Applicant respectfully submits that the discarding of images taught by Richey materially changes the characteristics of the Applicants invention. *In re De Lajarte*, 143 U.S.P.Q. 256 (CCPA 1964), MPEP 2111.03.

As Applicant has previously asserted, Richey fails to address the issue created by the spike generated in the ECG by the pacemaker. The mere pacing of the heart does not address the issue of the unacceptable spike. Applicant submits that the system taught by Richey results in unacceptable variations in the cardiac cycle, including those found where the cardiac period is stabilized, are discarded. [Richey, Col 3, Lines 20-23, Col 4, Lines 48-54]. Due to irregularities in the cardiac cycle, Applicant submits that Richey places tolerances on the correspondence of the trigger to the actual cardiac rhythm. If the cardiac rhythm is outside of the tolerance band, the image is discarded. [Richey, Col 4, Lines 50-54].

Since there are variations in the cardiac cycle, Applicant respectfully submits that the system of Richey does not maintain the patient at a fixed asynchronous rate as required by Claim 1. Accordingly, Applicant submits that the proposed combination of

Daum with Richey would operate in a materially different manner than independent Claim 1 as the discarding of the images would not resolve the problem of the spike created in the ECG by the pacemaker. Therefore, Applicant respectfully submits that Claims 1 and 3-9 are not obvious in light of Daum in further view of Richey. Reconsideration and withdrawal of this rejection is respectfully requested.

In view of the foregoing, Applicant submits that the Daum and Richey fail to teach or suggest each and every element of the claimed invention and are therefore wholly inadequate in their teaching of the claimed invention as a whole, fail to motivate one skilled in the art to do what the patent Applicant has done, fail to recognize a problem recognized and solved only by the present invention, fail to offer any reasonable expectation of success in combining Daum and Richey to perform as the claimed invention performs, fail to teach a modification to prior art that does not render the prior art being modified unsatisfactory for its intended purpose, and discloses a substantially different invention from the claimed invention, and therefore cannot properly be used to establish a prima facie case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of all rejections under 35 U.S.C. §103(a), which Applicant considers to be traversed.

If a communication with Applicant's Attorneys would assist in advancing this case to allowance, the Examiner is cordially invited to contact the undersigned so that any such issues may be promptly resolved.

The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 07-0845.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above-identified Deposit Account.

Respectfully submitted,

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